

DETAILED ACTION

1. The following is a non-final, office action on the merits. Claims 1-20, as originally filed, are currently pending and have been considered below.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 10-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 10-12, as best understood, it appears that the claimed method steps could simply be performed by mental process alone and are not statutory. Based on Supreme Court precedent ¹ and Federal Circuit decisions a §101 process must

(1) be tied to another statutory class (such as a particular apparatus) or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing. ²

The independent claim is directed towards steps of "creating", "converting", and "printing". Since the claims are directed to a process without including another statutory class of invention (manufacture, machine, composition of matter), these claims fall within the scope of human intelligence alone, and are non-statutory.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advance. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

Regarding claim 13, the claim is directed to a program per se, which is considered functional descriptive material, and is not statutory. MPEP 2106.01 describes why a claim to functional descriptive material is non-statutory.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1–5, 7, 9, 10, 12 and 14–20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mukaiyama et al. (US 2002/0138557).**

As per claim 1, Mukaiyama et al. discloses an advertisement system using, using a printing apparatus comprising:

- a layout setter providing layout information regarding document data and advertisement data to be printed on a paper;
- a document data processor that creates print data for a document by converting the document data into a predetermined printing apparatus description language based on the layout information provided by the layout setter, the document data generated using a predetermined application program;
- an advertisement data processor creating print data for an advertisement by processing a predetermined advertisement data according to the layout information provided from the layout setter;

and a combining unit combining the print data for the document sent from the document data processor and the print data for the advertisement sent from the advertisement data processor to create combined print data including the advertisement (See FIGS. 18, 46, 49, and paragraphs [0403] [0397] [0050]).

As per claim 2, Mukaiyama et al. discloses an advertisement server connected to the advertisement data processor via a network and providing the predetermined advertisement data to the advertisement data processor (See FIGS. 47 and 35).

As per claim 3, Mukaiyama et al. discloses the layout setter sets one of first through third layouts, the first layout in which the advertisement data is illustrated in an advertisement area of the paper, the second layout in which the advertisement data is illustrated in a divided area of the paper, and the third layout in which the advertisement data is illustrated in the entire area of the paper (See FIG. 46 and paragraph [0392]).

As per claim 4, Mukaiyama et al. discloses the layout setter sets one of first through third layouts, the first layout in which the advertisement data is illustrated in an advertisement area of the paper, the second layout in which the advertisement data is illustrated in a divided area of the paper, and the third layout in which the advertisement data is illustrated in the entire area of the paper (See FIG. 46 and paragraph [0392], it states that the spaces can differ as with having full page advertisements).

As per claims 5, Mukaiyama et al. discloses the document data processor scales down a size of the document data according to a predetermined ratio when the first or second layout is selected (See paragraph [0059]).

As per claim 7, Mukaiyama et al. discloses the document data processor scales down a size of the document data according to a predetermined ratio when the first or second layout is selected (See paragraph [0059]).

As per claim 9, Mukaiyama et al. discloses the advertisement server provides the advertisement data to the advertisement data processor, based on user information (See FIG. 49, step 212 (user information)).

As per claim 10, Mukaiyama et al. discloses an advertisement method using, using a printing apparatus comprising:
creating layout information regarding document data and advertisement data to be printed on a paper;
converting the document data into print data for a document, based on the created layout information and printed apparatus setting information, the document data generated using a predetermined application program;
creating print data for an advertisement by processing a predetermined advertisement data based on the layout information;
creating combined print data including the advertisement by combining the print data for the document and the print data for the advertisement; and printing the combined print data including the advertisement (See FIGS. 18, 46, 49, and paragraphs [0403] [0397] [0050]).

As per claim 12, Mukaiyama et al. discloses the predetermined advertisement data is provided from an advertisement server connected to a network (See page 9, paragraph [0148], which discusses the server selecting advertisement data to be outputted. Page 5, paragraph [0079] discusses the server being connected via a network such as the internet).

As per claim 14, Mukaiyama et al. discloses a machine readable storage storing at least one program controlling a computer according to a process (See page 4, paragraph [0074], which discusses computer recording medium such as CD-ROM and the management of the information processing) comprising:
providing selectable layout information regarding document data and advertisement data to be printed on paper (See page 8, paragraph [0134], which discusses a user selecting a desired form pattern (layout)),
converting the document data into print data based upon the selected layout information and printing the document data (See page 4, paragraph [0074], which discusses image processor 3, which takes the inputs from the layout setter (form 1) and generates the document 4a and 4b according to FIG. 1);
creating print data for a predetermined advertisement based upon the selected layout information, creating combined print data including the advertisement by combining the print data for the document data and the print data for the advertisement (See page 4, paragraph [0074], which discusses image processor 3, and the specific image component 3b, which handles advertisements received from 1b (layout information));

creating combined print data including the advertisement by combining the print data for the document and the print data for the advertisement; and printing the combined print data including the advertisement (See page 4, paragraph [0074], which discusses image processor 3, and component 3c, the image combination editing unit, and the combined printed product 4, as shown in FIG. 1).

As per claim 15, Mukaiyama et al. discloses the selectable layout information comprises one of first through third layouts, the first layout in which the advertisement is printed in an advertisement area of the paper (See page 9, paragraph 0140], which discusses the advertisement being placed in the blank space of FIG. 27), the second layout in which the advertisement is printed in a divided area of the paper (See page 9, paragraph 0141], which discusses the advertisement being further divided into advertisements parts 1 and 2 as shown in FIG. 28), and the third layout in which the advertisement is printed in the entire area of the paper (See page 5, paragraph [0091], which discusses the various shapes that can be used for advertisement layouts. Of the shapes shown in FIG. 6, it states that those patterns are examples only and not limited to those shapes only. Examiner contends this incorporates full page advertisements).

As per claim 16, Mukaiyama et al. discloses an advertising method, comprising: printing a combined print data of a document and an advertisement in response to a request to print the document (See page 8, paragraph [0123], which discusses the request for a form (combined document and advertisement data) by a user, and the process flow according to FIG. 33, which ends with the data being sent to

the server. Page 4, paragraph [0079] discusses the server being connected to processor 3 and the print flow process associated with processor 3 is shown in FIG. 1).

As per claim 17, Mukaiyama et al. discloses an advertising method, comprising:
providing office type printing services using a printing device (See Abstract, which discusses print services using a printer for image information such as advertisements); generating a combined print data of a document and an advertisement in response to a request to print the document by the printing device; and printing the combined data by printing device (See page 8, paragraph [0123], which discusses the request for a form (combined document and advertisement data) by a user, and the process flow according to FIG. 33, which ends with the data being sent to the server. Page 4, paragraph [0079] discusses the server being connected to processor 3 and the print flow process associated with processor 3 is shown in FIG. 1).

As per claim 18, Mukaiyama et al. discloses providing selectable print layouts and combining the document and advertisement print data according to the print layout (See page 8, paragraph [0134], which discusses a user selecting a desired form pattern (layout)).

As per claim 19, Mukaiyama et al. discloses the advertisements are according to a user information (See page 6, paragraph [0097], which discusses fields for information on the user and information on the advertisement as shown in FIG. 8).

As per claim 20, Mukaiyama et al. discloses a printer (See page 1, paragraph [0013], which discusses a printer to output document image information comprising: a programmed processor providing selectable layout information regarding document data and advertisement data to be printed on paper (See page 4, paragraph [0074], which discusses image processor 3, and the printing of document and advertisement data according to FIG. 1);

converting the document data into print data based upon the selected layout information upon printing the document data (See page 4, paragraph [0074], which discusses image processor 3, which takes the inputs from the layout setter (form 1) and generates the document 4a and 4b according to FIG. 1);

creating print data for a predetermined advertisement based upon the selected layout information,

(See page 4, paragraph [0074], which discusses image processor 3, and the specific image component 3b, which handles advertisements received from 1b (layout information));

creating combined print data including the advertisement by combining the print data for the document data and the print data for the advertisement, and printing the combined print data including the advertisement (See page 4, paragraph [0074], which discusses image processor 3, and component 3c, the image combination editing unit, and the combined printed product 4, as shown in FIG. 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 6, 8, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukaiyama et al. (US 2003/0164979), in view of Kawai (US 6,862,107).**

As per claims 6, 8: Mukaiyama et al. discloses the elements of the claimed invention, but fails to explicitly disclose the advertisement data processor performs watermark processing for the advertisement data when the third layout is selected.

Kawai discloses the advertisement data processor perform watermark processing for advertisement data (See col 2, lines 1-8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add watermarks on images to the system of Mukaiyama et al. in order to provide a good measure of security and authentication within the printed documents.

As per claim 11, Mukaiyama et al. discloses the layout information contains at least one of a desired layout, a scale-down ratio of a display size for the document data (see paragraph [0059]).

However, Mukaiyama does not disclose intensity information of watermark processing.

Kawai discloses intensity information of watermark processing (See col 2, lines 1-8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add watermarks on images to the system of Mukaiyama et al. in order to provide a good measure of security and authentication within the printed documents.

As per claim 13, Mukaiyama et al. discloses a computer readable recording medium storing programs executable by a computer, wherein the programs comprise:

a first program creating layout information containing layouts of document data and advertisement data to be printed on a paper, a scale-down ratio of a display size of the document data;

a second program converting the document data into print data for a document based on the layout information and printer setting information, the document data generated using a predetermined application program;

a third program creating print data for an advertisement by processing a predetermined advertisement data based on the layout information; and

a fourth program creating combined print data including the advertisement by combining the print data for the document and the print data for the advertisement (See FIGS. 18, 46, 49, and paragraphs [0403] [0397] [0050] [0059] [0061]).

However Mukaiyama et al. fails to explicitly disclose, and watermarking intensity information.

Kawai discloses intensity information of watermark processing (See col 2, lines 1-8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add watermarks on images to the system of Mukaiyama et al. in order to provide a good measure of security and authentication within the printed documents.

Response to Arguments

6. The applicant's arguments are moot in light of the new grounds of rejection above.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney M. Henry whose telephone number is 571-270-5102. The examiner can normally be reached on Monday through Thursday from 7:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rmh

/Arthur Duran/

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